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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,500	01/07/2002	Nigel M. Goble	2558-57	4541
7590	01/06/2004		EXAMINER	
NIXON & VANDERHYE P.C. 8th Floor 1100 North Glebe Road Arlington, VA 22201			VRETTAKOS, PETER J	
			ART UNIT	PAPER NUMBER
			3739	

DATE MAILED: 01/06/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/036,500	GOBLE, NIGEL M. <i>On</i>	
	<b>Examiner</b>	<b>Art Unit</b>	
	Peter J Vrettakos	3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 22 October 2003.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) 1-30 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 31-33,35-38 and 43 is/are rejected.
- 7) Claim(s) 34,39-42 and 44-47 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 07 January 2002 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.  
5) Notice of Informal Patent Application (PTO-152)  
6) Other: \_\_\_\_\_

## DETAILED ACTION

The Applicant has elected without traverse group II, claims 31-47.

Claims 1-30 are non-elected.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 31, 32, 33, 35, 37-38, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eggers ('592) in view of Hart et al. ('992).

#### Independent claim 31

Eggers discloses a method of treating a tumor in a colon (col. 23:60-64) using an electrosurgical system (11) comprising:

a generator (28);  
an electrosurgical instrument (10) with an active electrode (58);  
a fluid delivery means (59) for delivering electrically conductive fluid (50); and  
a return electrode (56).

the method comprising the steps of:

operating (83) the fluid delivery means to at least partly fill a space (L1,FIG. 2a) with fluid;

operating the generator to apply a RF voltage (col. 21:16-19); and manipulating the active electrode (58) to the vicinity of the tumor (52) to be treated. See figure 2a.

*Eggers neglects to disclose an electrosurgical method in which a space in the colon is enclosed.*

Hart et al. (Hart) discloses a surgical access device in which an anatomical cavity (an enclosed space) is created in which surgical intervention is made (see figure 10). The anatomical cavity can include a surgically induced cavity in the colon. **Note the similarities to figure 10 and the Applicant's figure 10.**

Dependent claims

Re: claim 32, Eggers discloses vaporization (col. 4:49-65).

Re: claim 33, Eggers discloses positioning the return electrode (56) within the space (see fig. 2a).

Re: claim 35, Eggers discloses continual fluid application (col. 15:53-56) and in an alternate embodiment, waste removal (266, figure 20, col. 23:25-28).

Re: claim 37, Hart discloses a flexible enclosing member (60).

Re: claim 38, Hart discloses manipulating pressure (col. 9:52-54).

Re: claim 43, Hart discloses endoscopy / laparoscopy (col. 1:16-18).

Therefore, at the time of the invention it would have been obvious to one of ordinary skill in the art to modify Eggers in view of Hart by including as a method step sealing an enclosed space in which surgical intervention is made. The motivation is found in Hart col. 3:5-10, which asserts that the invention obviates the need for a trocar or cannula.

2. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eggers ('592) in view of Hart et al. ('992) and further in view of Eggers et al. ('532).

Eggers et al. ('532) discloses the analogous invention to Eggers ('592), however, Eggers et al. ('532) discloses that the electrically conductive liquid can be a gas (col. 11:47-53).

Therefore, at the time of the invention it would have been obvious to one of ordinary skill in the art to modify Eggers in view of Hart and further in view of Eggers et al. by including as a design expedient electrically conductive gas. The motivation is to provide the advantages of anatomical cavity gas insufflation as shown in Hart (col. 1:30-33).

#### ***Allowable Subject Matter***

Claims 34,39-42, and 44-47 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art neglects to

disclose proximal and distal bungs used in the context found in claim 39, as well as a flexible sleeve inserted around the colon as found in the context found in claim 44.

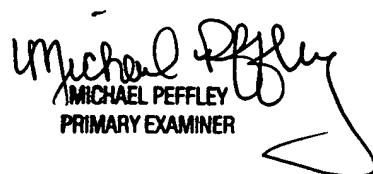
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Matyas ('106), Silvanov ('223).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter J Vrettakos whose telephone number is 703 605 0215. The examiner can normally be reached on M-F 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C Dvorak can be reached on 703 308 0994. The fax phone number for the organization where this application or proceeding is assigned is 703 746 7013.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 0858.

Pete Vrettakos  
January 2, 2004

  
MICHAEL PEFFLEY  
PRIMARY EXAMINER